

REMARKS

This Response is submitted in reply to the Office Action mailed on October 28, 2003. Claims 1-7, 9, 11, 12, 14-31 and 33-53 are pending in this application. Claims 15-31 and 33-53 are allowed. Claims 2, 5, 6 and 7 have been canceled. New claims 54-74 have been added. No new matter has been added by any of the amendments made herein. Claims 1, 3, 4 and 9 were rejected under 35 U.S.C. § 102(e); claim 14 was rejected under 35 U.S.C. § 102(e); claim 14 was rejected under 35 U.S.C. § 103(a); and claims 11 and 12 were rejected under 35 U.S.C. § 103(a). Claims 2, 5-7 were objected to as being dependent upon a rejected base claim.

As a preliminary matter, Applicants believe that the Patent Office incorrectly stated that claim 32 was pending and allowed in the above-identified patent application. Claim 32 was objected to in the previous Office Action dated April 16, 2003. In Applicants' Response to this Office Action dated July 17, 2003, Applicants canceled claim 32 and added new claim 45 which includes the elements of claim 26 and objected to claim 32. Accordingly, Applicants respectfully submit that claims 1-7, 9, 11, 12, 14-31 and 33-53 are presently pending in the above-identified patent application.

As another preliminary matter, claims 2, and 5-7 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Applicants added new claim 54 which includes the elements of independent claim 1 and objected dependent claim 2. Therefore, Applicants respectfully submit that new independent claim 54 as well as new claims 55-61, which depend from new claim 54, are in condition for allowance.

Similarly, Applicants added new claim 62, which includes the elements of independent claim 1, dependent claim 4 and objected dependent claim 5. Applicants respectfully submit that new claim 62 as well as new claims 63-67, which depend from new claim 62, are in condition for allowance. Moreover, the element of objected claim 6 is included as new claim 64, which depends from new claim 62. Therefore, Applicants respectfully submit for the reasons provided above that new claim 64 is in condition for allowance.

Applicants also added new claim 68, which includes the elements of independent claim 1 and objected dependent claim 7. Therefore, Applicants respectfully submit that new claim 68 as well as new claims 69-74, which depend from new claim 68, are in condition for allowance.

Claims 1, 3, 4 and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2002/0078559A1 to Buchwalter et al. ("*Buchwalter*").

Applicants respectfully submit that *Buchwalter* is not a proper prior art reference with respect to the claimed invention and therefore cannot anticipate the claimed invention under §102(e). As stated in Applicants' previous Response dated July 17, 2003, §102(e) states that a person shall be entitled to a patent unless the invention of the patent was described in "an application for patent, published under § 122(b), by another filed in the United States before the invention by the applicant for patent . . ." (emphasis added). Applicant may be able "to overcome the 35 U.S.C. § 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. § 119 priority date which is earlier than the references U.S. filing date." See MPEP § 2136.03. The present application claims foreign priority under 35 U.S.C. § 119 to an earlier filed foreign application, Japanese Patent Application No. P2000-380944, which was filed on December 14, 2000. The effective U.S. filing date of *Buchwalter* is December 27, 2000. Because the earliest effective filing date of the present application is earlier than the earliest effective U.S. filing date of *Buchwalter*, *Buchwalter* is not prior art which can be cited against the present application.

Per the Examiner's request, Applicants mailed an English Translation of the Japanese priority document and a statement that the translation of the certified copy of the document is accurate on October 1, 2003 to the Examiner. However, the Examiner has not confirmed whether the English translation of the priority document and the statement were received by the Examiner. Therefore, Applicants have re-submitted the English translation of certified Japanese Priority Document No. P2000-380944 and the statement that the translation of the certified copy of the document is accurate with this Response. These documents perfect Applicants' claim for priority in accordance with MPEP 706.02(b). For these reasons, Applicants respectfully request that the rejection under § 102(e) based on *Buchwalter* be withdrawn.

Claim 14 was rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2002/0082543 to Park et al. ("*Park*").

Applicants respectfully submit that *Park* is not a proper prior art reference under §102(e). As described above, the present application claims foreign priority under 35 U.S.C. § 119 to the earlier filed Japanese Patent Application No. P2000-380944, which was filed on December 14, 2000. The effective U.S. filing date of *Park* is December 14, 2000. Because the earliest

effective of *Park* is not before the earliest effective filing date of the present application, *Park* is not prior art which can be cited against the present application. Additionally, as describe above, Applicants have re-submitted the English translation of certified Japanese Priority Document No. P2000-380944 and the statement that the translation of the certified copy of the document is accurate. These documents perfect Applicants' claim for priority in accordance with MPEP 706.02(b). For these reasons, Applicants respectfully request that the rejection of claim 14 under § 102(e) be withdrawn.

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0055239 to Tuominen ("*Tuominen*").

Applicants respectfully submit that *Tuominen* does not teach or suggest the elements of claim 14. Claim 14 is directed to a device holding substrate including a substrate and a silicone resin layer provided on the substrate. The surface of the silicone resin layer has a recessed portion shaped to fit a pointed head portion of a device. The Patent Office states that *Tuominen* teaches all of the elements of claim 14 and, in particular, the silicone resin layer provided on the substrate where the silicone resin layer has a recessed portion shaped to fit a pointed head portion of a device. Applicants respectfully disagree.

Tuominen describes nanocylinder arrays and method for fabricating such arrays. The arrays are produced by orienting copolymer films and removing a component from the film to produce nanopores. The nanopores can then be filled with materials to produce the arrays. The resulting arrays are used to produce nanoscale media, devices and systems. (See the Abstract). *Tuominen* does not disclose, teach or suggest a silicone resin layer provided on a substrate where the layer has a recessed portion shaped to fit the surface of another device. *Tuominen* describes nanopores which can be filled with materials but does not teach or suggest that the nanopores can receive a surface or a portion of a surface of another device. Additionally, the Patent Office states that *Tuominen* teaches or suggests a device having a pointed head portion. In particular, the Patent Office states that paragraph 0017 of *Tuominen* describes such a device. Paragraph 0017, however, does not disclose or suggest a device having a pointed portion or any similar shape. *Tuominen* actually states that the "cylinders can have various shapes and can, but need not to, have a circular diameter cross-section." The cylinders refer to cylindrical pores and not the surface of another device as in the claimed invention. Also, *Tuominen* only describes the pores having a cylindrical shape. A cylindrical shape or cylinder is defined as a "solid bounded

by two parallel planes in such a surface, especially such a surface having a circle as its diuretics.” (See the American Heritage Dictionary, Fourth Edition). Therefore, a cylinder is a solid object or shape that has two parallel planes. The pointed head portion of the device of claim 14 has intersecting or non-parallel planes. Therefore, *Tuominen* is describing cylinders or cylindrical shapes that have various different shape cylinders and cylinders having different diameter cross-sections but does not teach or suggest other shapes that are not cylinders.

Applicants therefore respectfully submit that *Tuominen* does not disclose, teach or suggest the elements of claim 14. Accordingly, Applicants respectfully submit that claim 14 is in condition for allowance.

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buchwalter* in view of U.S. Patent No. 5,929,962 to Chiu et al. (“*Chiu*”) and in further view of U.S. Patent No. 4,451,634 to Hatanaka et al. (“*Hatanaka*”). Applicants submit that the combination of *Buchwalter*, *Chiu* and *Hatanaka* does not teach or suggest all of the elements of Claims 11 and 12.

Buchwalter is not a proper prior art reference as described above. Therefore, the combination of *Buchwalter*, *Chiu* and *Hatanaka* does not disclose or suggest all of the elements of Claims 11 and 12. For these reasons, Applicants respectfully submit that Claims 11 and 12 are patentable over the art of record.

In light of the above, Applicants respectfully submit that claims 1, 3-4, 9, 11, 12 and 14 and new claims 54-74 are novel and nonobvious over the art of record because the cited references, either alone or in combination, do not disclose, teach or suggest the elements of these claims. Accordingly, Applicants respectfully request that claims 1, 3-4, 9, 11, 12 and 14, new claims 54-74, as well as allowed claims 15-31 and 33-53, be deemed allowable at this time and that a timely notice of allowance be issued in this case.

Applicants acknowledge that a three-month extension of time is due in connection with this response. In addition, several new claims have been added to patent application. Therefore, a check in the amount of \$1,974.00 is enclosed herewith to cover the fees for the three-month extension and the newly added claims. If any other fees are due in connection with this application, the Patent Office is authorized to deduct the fees from Deposit Account 02-1818. If

such a withdrawal is made, please indicate the Attorney Docket No. (112857-306) on the account statement.

Respectfully submitted,

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